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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,025	06/17/2001	Gilad Lavi	P31438 USA	9705
61214	7590	07/02/2008		
Fox Rothschild, LLP 10 Sentry Parkway, Suite 200 P.O. Box 3001 Blue Bell, PA 19422-3001			EXAMINER STIGELL, THEODORE J	
			ART UNIT	PAPER NUMBER
			3763	
			MAIL DATE	DELIVERY MODE
			07/02/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/883,025

Applicant(s)

LAVI ET AL.

Examiner

THEODORE J. STIGELL

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-16 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 and 13-16 is/are allowed.
- 6) ☒ Claim(s) 28-31 is/are rejected.
- 7) ☒ Claim(s) 1-11 and 13-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/18/2008 has been entered.

Claim Objections

Claims 1-11 and 13-16 are objected to because of the following informalities:

In regards to claim 1, there appears to be two different "surfaces" recited (line 2 and line 14), but it is the examiner's position that the claims should recite only one surface. Other dependent claims such as claims 3 and 4 further recite "site surface". The examiner believes that all of these terms refer to the same surface and therefore the same term(s) should be used throughout the claims.

In regards to claim 2, please correct the antecedent basis problem for "a retracted position".

In regards to claim 9, the examiner contends that "movable" should be "movably".

In regards to claim 10, the examiner notes that the independent claim now requires two "unactuated positions". Claim 10 appears to only recite one "unactuated position" and should be changed.

In regards to claim 13, the claim should specify which "unactuated" position the actuator is prevented from moving to.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by Davison et al. (5,279,582). Davison discloses a needle device comprising a housing (18') having a base (52) for placement against a surface of a needle penetrating site, the base including a first opening (not numbered), a needle (16) mounted for movement between a retracted position (Figure 9) in the housing and an extended position (Figure 10), where a portion of the needle extends through the opening when in the extended position, an actuator (12, 21) movably mounted to the housing and movable between an unactuated position at which the needle is in the retracted position and an actuated position at which the needle is in the extended position, the actuator biased to the unactuated position, a retraction mechanism (44) that automatically moves the needle from the extended position to the retracted position, the retraction mechanism being configured to begin moving the needle to the retracted position after release of the base from next to the surface. The examiner maintains that the device is capable of performing this function if the device was quickly moved away from the skin.

Claims 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/22790 to Elan Corporation (hereafter Elan). Elan discloses a needle device comprising a housing (11) having a base (distal end of cover 20) for placement against a surface of a needle penetrating site, the base including a first opening (21), a needle (15) mounted for movement between a retracted position (Figure 3) in the housing and an extended position (Figure 4), where a portion of the needle extends through the opening when in the extended position, an actuator (12, 28) movably mounted to the housing and movable between an unactuated position at which the needle is in the retracted position and an actuated position at which the needle is in the extended position, the actuator biased to the unactuated position, a retraction mechanism (22) that automatically moves the needle from the extended position to the retracted position, the retraction mechanism being configured to begin moving the needle to the retracted position after release of the base from next to the surface, and further comprising a locking mechanism (23) and a cover member (20).

Allowable Subject Matter

Claims 1-11 and 13-16 are allowed under the condition that the minor informalities cited above are resolved.

Response to Arguments

Applicant's arguments, see Remarks, filed 4/18/2008, with respect to the rejection(s) of claim(s) 1-3 and 28-31 over the Martin reference have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

Applicant's arguments filed 4/18/2008 in regards to the Davison reference have been fully considered but they are not persuasive. The examiner maintains that the Davison reference is capable of moving the needle to the retracted position after the release of the base from next to the surface by quickly removing the device from the skin.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THEODORE J. STIGELL whose telephone number is (571)272-8759. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3763

/Theodore J Stigell/
Examiner, Art Unit 3763

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art Unit 3763